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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,356	05/24/2001	Olga Bandman	PF-0501-1 DIV	6186
27904	7590	01/16/2004	EXAMINER	
INCYTE CORPORATION 3160 PORTER DRIVE PALO ALTO, CA 94304			NOLAN, PATRICK J	
			ART UNIT	PAPER NUMBER
			1644	

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/866,356

Applicant(s)

BANDMAN ET AL.

Examiner

Patrick J. Nolan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,14-29,46 and 47 is/are pending in the application.
- 4a) Of the above claim(s) 14-16,19-29 and 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 17 is/are rejected.
- 7) ☒ Claim(s) 2,18 and 46 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

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1. Claims 1-2, 14-29 and 46-47 are pending.

Claims 14-16, 19-29 and 47 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions.

2. Claims 1 and 17 stand rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the use of SEQ ID NO. 1, does not reasonably provide enablement for the use of any protein that is 90% identical to SEQ ID NO. 1 or any biological fragment of SEQ ID NO. 1 or immunological fragment of SEQ ID NO. 1. The specification does not enable any person skilled in the art to which it pertains, or with which it is most clearly connected, to use the invention commensurate in scope with these claims, for reasons set forth in the Office Action mailed 7-14-2003.

Applicant's arguments filed 10-17-2003 have been fully considered but are not found persuasive.

Applicant argues that "one skilled in the art need not make and test vast numbers of polypeptides that are based on the amino acid sequence of SEQ ID NO.1. Instead, one skilled in the art need only screen a cDNA library or use appropriate PCR conditions to identify relevant polynucleotides/polypeptides that already exist in nature".

However, a requirement of the claim is that the resulting polypeptide binds DNA. How can one of skill in the art test a DNA sequence for polypeptide binding ability. In addition the claims are not limited to those polypeptides that already exist in nature, but to those naturally occurring polypeptides. It is unknown to science how many polypeptides exist, as all naturally occurring polypeptides that exist have not been isolated from all organisms. In fact all naturally occurring organisms have yet to be even discovered.

Applicant argues that one of skill in the art could assay PRAEP activity by using the teachings of the specification and identify functional sequence variants using said assays.

However, the actual DNA binding activity of SEQ ID NO. 1, is based solely on sequence identity to known domains of polypeptides which bind DNA. There is no description in the specification as to which amino acid residues could be changed and maintain this required DNA binding activity. A screening assay with no predictable result from the guidance set forth in the specification, sets up an undue amount of experimentation for those skilled in the art. Furthermore, the term naturally occurring doesn't limit the scope of the claim since it is unknown how many naturally occurring sequences there are.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Applicant is notified that claims 2, 18 and 46 are objected to as being dependent upon rejected claims.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is (703) 305-1987. The examiner can normally be reached on Tuesday through Friday from 9:00 am to 5:30 pm.

6. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at (703) 305-3973. The FAX number for our group, 1644, is (703) 305-7401.



Patrick J. Nolan, Ph.D.

Primary Examiner, Group 1640

1/8/04